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EXAMINER

KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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01/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/736,675

Applicant(s)

YODA, AKIRA

Examiner

JAMIE KUCAB

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/15/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION


Acknowledgements

1. Applicants' response filed November 28, 2007 is acknowledged.
2. Claims 1-18 are pending in the application.
3. This Office action is given Paper No. 20080116 for reference purposes only.
4. Based on a comparison of the PGPub US 2004/0139333 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Election/Restrictions

5. Newly submitted claims 13-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 13-18 are directed to a materially different method that is patentably distinct from the apparatus of claims 1-12 due to the added limitation that "at least one predetermined accessor is someone other than the first person."
6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

7. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim ~~5~~^{§ 13-18 are} withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. 

Information Disclosure Statement

8. The information disclosure statement (IDS) submitted on April 15, 2004 has been considered by the Examiner. The Seiichi Ido reference (in Japanese) has been considered to the extent possible based on the single page of English translation attached thereto.

Claim Objections

9. Claims 1 is objected to because of the following informalities:
10. In lines 1-2 of claim 1, applicant recites "owner's personal information". For purposes of examination and consistent with claim 12, the examiner is reading this as --an owner's personal information--.
11. In line 5 of claim 1, applicant recites "predetermined accessible persons". It is not clear whether applicant intends this to mean "a plurality of predetermined accessible persons" or "one or more predetermined accessible persons". The examiner is interpreting this limitation as --a plurality of predetermined accessible persons-- consistent with claim 1 lines 8-9.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 7, 9, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Houvener et al. (6,070,141).
14. Regarding claim 1, Houvener et al. disclose an information storing apparatus storing thereon owner's personal information, comprising:

a personal information storing section (disk array 19 in Fig. 3) storing thereon the owner's personal information ("the information", col. 10 line 43) which is to be disclosed to predetermined accessible persons;

an accessible person information storing section ("valid user database", col. 10 line 40) storing thereon accessible person characteristic information ("first and second ID units", col. 3 lines 55-56) indicating a physical characteristic ("retinal image", col. 9 line 20) of each of the plurality of accessible persons;

a requester authentication section (point of identification terminal 1 in Fig. 1) for receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section;

an access level setting section (controller 7 in Fig. 1) for setting an access level, which is a level of the personal information to be disclosed to the requester, when said requester authentication section authenticates the requester as the accessible person; and

a personal information output section (display 6 in Fig. 1) for outputting a part of the personal information stored on said personal

information storing section to the requester in accordance with the access level set-up by said access level setting section.

15. Regarding claim 7, Houvener et al. further disclose wherein said accessible person information storing section stores a plurality of accessible person characteristic information of each of the accessible persons ("first and second ID units", col. 3 lines 55-56), said requester authentication section receives a plurality of requester characteristic information (steps 220 and 245 in Fig. 6A), and performs authentication processing of the requester using the plurality of accessible person characteristic information and the plurality of requester characteristic information (step 260 in Fig. 6B).

16. Regarding claim 9, Houvener et al. further disclose wherein said requester authentication section employs face information ("retinal image", col. 9 line 20) as the requester characteristic information and the accessible person characteristic information.

17. Regarding claim 10, Houvener et al. further disclose the apparatus further comprising an image capturing section ("automated comparison system", col. 9 lines 17-18) for generating the requester characteristic information by capturing an image of the requester.

18. Regarding claim 11, Houvener et al. further disclose wherein said requester authentication section receives the requester characteristic information from a portable apparatus retained by the requester ("smart card", col. 10 line 29), and said personal information output section outputs the personal information to the portable apparatus

retained by the requester and causes the portable apparatus to store the personal information (col. 10 lines 29-30).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 2-6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houvener et al. (6,070,141) in view of Schneider et al. (6,105,027).

21. Regarding claims 2 and 3, Houvener et al. disclose the claimed invention, however, Houvener et al. fail to explicitly disclose the apparatus further comprising an access level storing section storing thereon a personal information level, which is a level of the personal information to be disclosed to the accessible person, and an authentication criterion, which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting section determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication section authenticates the requester by the authentication criterion. Schneider et al. teach an access level storing section (Fig. 6) storing thereon a personal information level ("Trust/Data Sensitivity Level" in Fig. 6), which is a level of the personal information to be disclosed to the accessible person,

and an authentication criterion ("Minimum Encryption" in Fig. 6), which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting section determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication section authenticates the requester by the authentication criterion (col. 18 lines 6-11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Houvener et al. to include the access level storing section of Schneider et al. in order to provide different levels of access to different users.

22. Regarding claims 4 and 5, Houvener et al. disclose the claimed invention, however, Houvener et al. fail to explicitly disclose wherein said access level storing section stores the plurality of personal information levels and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels, said requester authentication section outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information, and said access level setting section selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication section, and sets the access level to the sum of the selected personal information levels. Schneider et al. disclose an access level storing section that stores the plurality of personal information levels

("Trust/Data Sensitivity Level" in Fig. 6) and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels ("Minimum Authentication" in Fig. 6), said requester authentication section outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information (col. 19 line 55 - col. 20 line 11), and said access level setting section selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication section, and sets the access level to the sum of the selected personal information levels (col. 19 line 55 - col. 20 line 11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Houvener et al. to include the access level storing section of Schneider et al. in order to provide different levels of access to different users.

23. Regarding claims 6 and 12, Houvener et al. disclose the claimed invention, but Houvener et al. fail to explicitly disclose the apparatus further comprising wherein said access level storing section stores the personal information level and the authentication criterion in association with a title of the requester, said requester authentication section further receives the title of the requester from a belonging of the requester, and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing section, and said access level setting section sets the access level to the personal information level corresponding to the title of the requester when said

requester authentication section authenticates the requester as the accessible person. Schneider et al. teach an access level storing section (access filter 203 in Fig. 2) that stores the personal information level and the authentication criterion in association with a title of the requester ("UserGroupID" in Fig. 13A), said requester authentication section further receives the title of the requester from a belonging of the requester ("SmartCard" in Fig. 13A), and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing section, and said access level setting section sets the access level to the personal information level corresponding to the title of the requester when said requester authentication section authenticates the requester as the accessible person (col. 35 lines 4-23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Houvener et al. to include the access level storing section of Schneider et al. in order to more efficiently provide information access to groups of users.

24. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable Houvener et al. (6,070,141) in view of Examiner's Official Notice. Houvener et al. disclose the claimed invention, but Houvener et al. fail to explicitly disclose that the information storing apparatus is retained by the owner. However, the Examiner takes Official Notice that it is old and well known in the art to make an information storing apparatus portable such that it can be retained by the owner. It would have been obvious to a person having ordinary skill in the art at the time of invention to make the information storing

apparatus portable such that it can be retained by the owner in order to provide the owner of information with control over the security of that information.

Examiner Note

25. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

26. Functional recitation(s) using the word "for," "adapted to," or other functional language (e.g. see claim 1 which recites "for receiving requester characteristic information ...", "for setting an access level ...", etc.) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, the Examiner has considered the functional language. However, in a product claim, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product

from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2111.04 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

27. If Applicant(s) desire to give the functional phrase(s) greater patentable weight, the Examiner respectfully recommends (by way of example only) Applicant(s) remove "for," "adapted to," or other functional language from the phrase(s) where intended use is *not* desired. For example, a hypothetical claim with a positive recitation would be 'a computer processing the instructions' instead of a functional recitation such as 'a computer *for* processing the instructions' Like always, Applicant(s) are reminded that any amendment must not constitute new matter.

28. The USPTO interprets claim limitations that contain statement(s) such as "*if, may, might, can, could, when, potentially, possibly*", as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Definitions

29. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.² Finally, the following list is not intended to be exhaustive in any way:

30. "criterion" is interpreted by the Examiner as follows:

1. a standard by which something can be judged or decided.³

Response to Arguments

31. Applicant's arguments with respect to the objections to the IDS have been fully considered and are persuasive. The objection to the IDS has been withdrawn.

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

² See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; "resort must always be made to the surrounding text of the claims in question").

³ "criterion." Collins English Dictionary. 2000. CredoReference. Retrieved on 17 January 2008 from <<http://www.credoreference.com/entry/2634677>>.

32. Applicant's arguments with respect to the 112 2nd rejections of claims 1-12 have been fully considered but they are not fully persuasive.

33. Applicant's arguments with respect to the 102(b) and 103(a) rejection of claims 1-12 have been fully considered but they are not persuasive.

34. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "multiple accessible persons may be granted at least partial access to one owner's personal information") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

35. In response to applicant's argument that the references fail to show "receiving a title of the request" and "performing the authentication processing by a predetermined strictness of the authentication corresponding to the title", Schneider teaches the use of user groups to control access to data. These user groups are typically titles, e.g., "Engineers" or "Administrators". These user groups each require a different "mode of identification" which corresponds to Applicant's "predetermined strictness of authentication" (Schneider, C12 L48-57).

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

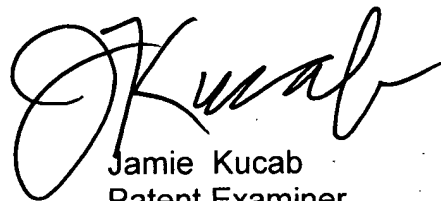
38. References considered pertinent to Applicant(s)' disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 1/17/08

Jamie Kucab
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